

In re: Ying *et al.*
Serial No.: 09/776,484
Filed: February 2, 2001
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REMARKS

Applicants appreciate the thorough review of the present application, and the indication that the rejections under 35 U.S.C. § 112 have been withdrawn. Claims 1, 3-17, 19-21, 23 and 25-34 remain pending, and each of these claims stand rejected. In particular, Claim 31 stands rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. 2001/0016822 A1 to Bessette ("the Bessette publication"), and Claims 1, 3, 5, 7-9, 15-17, 19, 21, 23, 25-27, 30 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Bessette publication in view of U.S. Patent Publication No. 2004/0138569 A1 to Grunwald *et al.* ("Grunwald"). Claims 4, 6, 10-14, 20, 28-29 and 33-34 stand rejected under 35 U.S.C. § 103 based on the combination of the Bessette publication, Grunwald and various additional secondary references.

Applicants have amended independent Claim 1 and dependent Claim 2 to return them to their original, as-filed, condition. Applicants have amended independent Claims 17, 23, 25, 31 and 32 to remove the recitation "in their entirety" therefrom. As discussed below, each of the pending rejections should be withdrawn because the cited portions of both the Bessette publication and Grunwald do not constitute prior art to the present application, and hence cannot be used to support rejections of the pending claims under either 35 U.S.C. §§ 102 or 103.

In particular, the present application was filed on February 2, 2001. Grunwald was filed on October 29, 2003. Grunwald does, however, claim priority to several prior patents, including one patent (U.S. Patent No. 6,251,073 to Imran *et al.* or "Imran") having a filing date that predates the filing date of the present application. Thus, Grunwald is only prior art to the present application to the extent that the subject matter contained in Grunwald is disclosed in Imran.

In rejecting the pending claims, the Official Action relies on Grunwald as disclosing, among other things, "providing ergonomic buttons to move between different screens containing different information, wherein each ergonomic button is large enough for a user's finger." (*See, e.g.*, the Action at page 3, citing to paragraphs 16 and 23 of Grunwald). Applicants have carefully reviewed Imran and determined that Imran does not include the subject matter recited in paragraphs 16 and 23 of Grunwald. In fact, Applicants were unable

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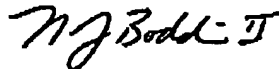
to identify any disclosure whatsoever in Imran relating to the use of ergonomic buttons, providing buttons that can be selected by a user's finger, etc. Accordingly, as the cited portions of Grunwald are not supported by the earlier Imran patent from which Grunwald claims priority, the cited portions of Grunwald do not constitute prior art and cannot be used to reject the pending claims. As such, the pending rejections should be withdrawn and the application passed to issuance.

In addition, Applicants also note that the Bessette publication is based on a patent application filed on December 13, 2000. Applicants are filing herewith a *Declaration Pursuant to 37 C.F.R. § 1.131*, which establishes that Applicants were in possession of the claimed invention prior to December 13, 2000. As such, the Bessette publication only qualifies as prior art to the extent that it is supported by the parent application from which it claims priority, namely U.S. Patent Application No. 09/087,843, which has now issued as U.S. Patent No. 6,263,330 ("the Bessette patent"). The pending rejections cite to the Bessette publication as disclosing (at paragraph 99), among other things, formatting medical records for presentation on a mobile terminal and delivering such formatted medical records to a mobile terminal. (See the Action at page 4, incorporating the arguments from the prior Office Action). Applicants have also carefully reviewed the Bessette patent and determined that it does not include the subject matter recited in paragraph 99 of the Bessette publication. In fact, Applicants were unable to identify any disclosure whatsoever in the Bessette patent involving mobile terminals or formatting records for presentation on mobile terminals. Accordingly, as the cited portions of the Bessette publication are not supported by the earlier Bessette patent from which the Bessette publication claims priority, the cited portions of the Bessette publication do not constitute prior art and cannot be used to reject the pending claims. This provides a separate and independent basis for withdrawal of the pending rejections.

In light of the above, Applicants respectfully request that the Examiner enter the above amendments and reconsider and withdraw the pending rejections.

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